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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/742,622

12/21/2000

Curtis Cole

JBP-534

7817

7590

04/19/2006

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,622

Applicant(s)

COLE ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-20, 22, and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/11/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 13, 2005 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites "said compound" in claim 13. Claim 22 is vague and indefinite because it is not clear whether applicant is referring to a single amine salt compound or the mixture of the two amine salt compounds that are required in claim 13.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9, 11, 13-18, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu et al. (US 4197316). ("Yu").

Yu discloses a method to treat dry skin, including facial skin, using topical composition which comprise one or more alpha hydroxy acids, esters thereof, and their ammonium salts. See abstract; col. 1, lines 16 – 40. Compositions containing ethanolamine salt of glycolic acid and triethanolamine salt of lactic acid are disclosed. See Examples 1-5. Example 5 particularly discloses a composition comprising 2 % of citric acid, 2 % of lactic acid, 2 % of glycolic acid, and 3 % of ethanolamine. See instant claims 6, 11, 17, and 22. Using malic acid is also suggested. See col. 1, line 60; col. 3, line 30; instant claims 7 and 18. The method preparing the ammonium salt of the hydroxyacid is taught in the reference. The reference also teaches that the ammonium salt thus formed needs no isolation procedure and may be directly incorporated into the therapeutic composition. See col. 3, lines 38 – 45; col. 3, lines 14 – 25. The reference also teaches that the compositions should have pH between 3.5 and 7.5. See col. 3, lines 35 – 37. See instant claims 9.

While the reference does not explicitly teach the administration of the prior art composition improves skin firmness, facial contours, and reduces the appearance of sagging skin, it is noted that the claimed method steps are anticipated by the prior art method of topically applying the said composition to the skin, including facial skin. Thus the claimed method is inherently practiced by the using the prior art as taught by the reference.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 8, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu as applied to claims 1-7, 9, 11, 13-18, 22, and 23 as above.

As discussed above, topically applying a composition comprising the recited acid salt of alkaloamine is known in cosmetic art. While Yu teaches using malic acid and glycolic acid, the reference fails to teach the specific weight ratio of the malic acid and glycolic acid.

Since the reference teaches that glycolic acid and citric acid are both used in 1:1 ratio and further teaches that malic acid also is preferably used in the invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teaching of the reference by using malic acid and glycolic acid in the same ratio in expectation of successfully producing a similar efficacy of the composition.

Furthermore, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in the prior art, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ratio of the active ingredients by routine experimentation.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu as applied to claims 1- 9, 11, 13-20, 22, and 23 above, and further in view of Quan et al (U.S. Pat. No. 6,180,133 B1) ("Quan").

Yu fails to teach using the composition with the articles as required by claim 12.

Quan teaches an adhesive, matrix-patch for treating wrinkle. The adhesive contains mixture of vitamins, alpha hydroxy acids or their salts, and glycerine. See col. 3, line 45 – col. 4, line 63; col. 4, lines 44 – col. 5, line 23. The reference teaches that the administration of the composition with the patch system is more effective than by hand, and provides the enhanced absorption of the therapeutic components into the skin. See col. 7, lines 7 – 35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of the Yu reference by incorporating the compositions into an adhesive patch, as motivated by Quan, because the skilled artisan would have had a reasonable expectation that the method would successfully deliver the alpha hydroxy acids more effectively to the skin.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 11-20, 22, and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-7, 10-12, and 14-16 of copending Application No. 09/677,737. Although the conflicting claims are not identical, both claims are directed to method of topically applying a composition comprising at least two acid salts of akanolamines having overlapping limitations. The application no. 09/677,737 claims method of ameliorating redness or inflammation of skin caused by irritating composition, acne lesion, or allergic reaction. Examiner takes the position that the claimed method in the present application obviously is performed by practicing the method of the copending application, since both methods require same method steps using same compositions.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

Applicant's arguments with respect to claims 1-9, 11-20, 22, and 23 have been considered but are moot in view of new ground(s) of rejection in part and unpersuasive in part.

Applicant asserts that the prior art method of relieving dry skin does not provide the 'physical movement and lifting of facial skin to define and reshape the contours' of the facial skin. In response, examiner notes that the rejection is made based on inherency. Applicant's argument would be valid if relieving dry skin and improving facial contours employ two different methods. However, in this case, both the prior art and

applicant use the same composition. It cannot be said that the same composition that is applied to the same area of skin only treats dryness and fails to provide the rejuvenating function as claimed by applicants. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. See In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Furthermore, under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. See In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). In this case, the prior art teaches a topical composition comprising at least two ethanolamine salts of alpha hydroxy acids, as claimed by applicants. Since the prior art method also requires topical application of the composition to skin, including facial skin, the composition will inherently perform the claimed method of improving skin firmness and facial contours and reducing the appearance of sagging skin.

Conclusion

No claims are allowed.

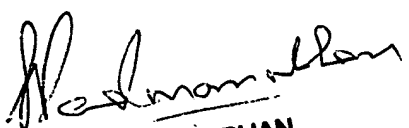
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605.

The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER